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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,382	10/27/2003	Martin Kleban	CH-7972/LeA 36,348	5763

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,382

Applicant(s)

KLEBAN ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/9/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5,7-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the process as defined in claim 4, does not reasonably provide enablement for the process using any other condensates within the scope of claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The examples and description in the specification are only directed to the use of the condensates as defined in claim 4. There is no evidence that applicant had in his possession at the time the invention was made a process of using any other condensates or the leather produced by said processes. There are a plethora of sulfonated aromatic condensates available to the skilled artisan. See, for example, the list in column 2 of Komforth et al., US 6,033,590. There is no evidence that applicant used any of the condensates listed there in the process of his invention except the one defined in claim 4 (without the optional addition of urea). In fact did applicant have in his possession any condensates which had any amount of the naphthalenesulphonic acid/formaldehyde condensates named in the

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proviso of claims 1 and 8? See examples 1 and 2 on page 12. Did applicant make any of the mixed products as claimed for use in the process claimed in claim 1 wherein the product comprises 0% of the phenol formaldehyde condensates in the proviso?

Applicant is asked to explain why the condensates were described by means of said proviso. Is there any process of retanning iron tanned leather known to applicant wherein the condensate of the proviso comprise 25% or more of the condensates used in the process?

Claims 1-3, 5,7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 and claim 4, applicant clearly defines only 25% or less by weight of the condensate . The claims are indefinite for failing to define the remainder of the composition of the condensate. The examiner suggests that the claims be directed to a process and product wherein the condensates which are used in the retanning are defined by chemical constitution, not by what is excluded.

No art rejections are applied because no art was found to anticipate or render obvious the process wherein iron-tanned leather is retanned with the condensation products as claimed.

The art of record applied shows the state of the art.

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Seigler et al. US 4,740,211, disclose a process of chromium-free tanning wherein leather is tanned with both phenolic syntans and iron tanning agents. However, the phenolic syntan is used before the iron tanning. Patentee does not suggest tanning with iron and then retanning with phenolic syntan and states that the reason for the success of the process is the order of addition of the tanning agents. See col 5 esp lines 5-19 and lines 41-63 and col 6 lines 1-6. There are no examples of using iron tanning although it is an alternative suggested by patentee, or is the condensate of the claimed process disclosed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Friday, March 18, 2005


Margaret Einsmann
Primary Examiner
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